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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,706	03/29/2004	Akihiko Shimasaki	KPC-0309	9050

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EXAMINER

CAMERON, ERMA C

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,706

Applicant(s)

SHIMASAKI ET AL.

Examiner

Erma Cameron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 8, 11, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9, 10, 13, 14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Claims 1-5, 8, 11-12, and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/2/2005.

The applicant says on page 6 that claims 7-10 and 14-21 now read on the elected specie.

However, that is not correct. Claims 8 and 15 are drawn to a resin containing a polyol. This is not the elected specie.

2. Applicant's election with traverse of Group II and a xylene-formaldehyde-resin-modified amino-containing epoxy resin as the specie in the reply filed on 9/2/2005 is acknowledged. The traversal is on the ground(s) that the examination can be done without serious burden. This is not found persuasive because there are three different base resins claimed, and now there are claims to film, coated article and method of making the coated article. This is a burden.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

3. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

It appears that the drawings illustrate prior art.

Specification

4. The disclosure is objected to because of the following informalities:
- a) The chemical formula at 13:14 is partly illegible.
 - b) Table 3 is partly illegible. It is the examiner's opinion that the table would have to be enlarged to be legible.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6-7, 9-10, 13-14 and 16-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following subject matter is not well defined and described:

- a) Table 1: what does EP in the last three boxes on page 48 mean?

The numbers in the boxes do not have units. Is this %?, wt%?

What are the numbers in parentheses, and what are the numbers above them?

MDI, MDI-PG and IPDI-OX need to be defined and written in full, for clarity.

- b) Table 2: The numbers in the boxes do not have units. Is this %?, wt%?

What are the numbers in parentheses, and what are the numbers above them?

- c) Table 3: What are the units of the numbers in this table?

d) 47:10-11 It is not clear what "parts" means, when the curing agent is given in grams.

e) Page 56: it is not clear why only one of the Japanese applications that are claimed as priority are mentioned on page 56.

7. Claims 6-7, 9-10 and 20-21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an article of metal with the films as defined, does not reasonably provide enablement for substrates other than metal. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

It appears from the specification that metal is the only substrate used in the claimed invention.

8. Claims 6 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a film or coated article that is based on the base resins as given in claim 14, does not reasonably provide enablement for a base resin of amino-epoxy resin alone. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

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Page 1, line 21 to page 1, line 13 teach that the amino-epoxy resin of JP 2000-007960 is not satisfactory to the applicant. Therefore, it appears that only one of the base resins of claim 14 will give satisfactory results in the claimed invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 6-7, 9-10, 13-14 and 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 13-14 and 16-19: it is not clear if a stand-alone film is being claimed, or a film on a substrate.

b) Claim 13 and 14: it is not clear if "modified amino-containing epoxy resin" means that the amino is modified or that the epoxy is modified in addition to being amino-containing, or perhaps some other definition. In addition, what is the modification that is referred to? Is the amino the modification itself?

c) Claim 17 (used twice): block should be blocked.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 6 and 13 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by the admitted state of the prior art.

Page 1, lines 13-page 2, line 13 teach that cationic coating compositions are known, such as the amino-epoxy resin of JP2000-007960 and page 10, lines 11-page 11, line 2 teach that conventional resins can form a coating film with the Tg and oxygen permeability as claimed.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 6 and 13 rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 2000-007960.

'960 teaches an amino-epoxy resin adduct with Tg of 70-90 C. which is encompassed by applicant's claimed range (see Abstract and translation). Because '960 teaches the same amino-epoxy resin adduct as applicant, it appears that the oxygen permeability would be inherent.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 6-7, 9-10, 13-14, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-306796.

'796 teaches a formaldehyde-, xylene-, and amino- reacted epoxy resin, used in an electrodeposition coating, along with a blocked polyisocyanate, which has been further reacted with polypropylene glycol (see Abstracts).

'796 does not teach the Tg, oxygen permeability or adhesive force of the coating mixture, but because the resin and blocked polyisocyanate are the same as claimed by applicant, these parameters are expected to at least overlap with the values claimed by applicant.

17. Claim 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-306796 taken in view of Nishiguchi et al (6492027).

'796 is applied here for the reasons given above.

'796 fails to teach a bismuth compound.

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'027 teaches a cationic epoxy-based coating composition that contains a bismuth compound as a rust preventative (8:24-53).

It would have been obvious to one of ordinary skill in the art to have incorporated the bismuth compound of '027 into the '796 process, because of the teaching of '017 that the compound prevents rust.

18. Claim 19 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-306796 taken in view of EP 1111013.

'796 is applied here for the reason given above.

'796 fails to teach a bismuth compound

'013 teaches the addition of a bismuth compound to an amino-epoxy cationic coating composition as a rust preventative (see Abstract, [0036]).

It would have been obvious to one of ordinary skill in the art to have incorporated the bismuth compound of '013 into the '796 process because of the teaching of '013 that the bismuth will serve to prevent rust.

19. Claims 6-7, 9-10, 13-14 and 16-21 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1314768.

'768 teaches a xylene-formaldehyde, amino-group containing epoxy resin (of epoxy equivalent 180-2500 (see Abstract, [0006]) and blocked polyisocyanate (reacted with propylene

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glycol or other compounds as a cationic coating composition [0040]-[0042]. A bismuth compound may be present as a rust preventative [0049]-[0052].

'68 does not teach the Tg, oxygen permeability or adhesive force of the coating mixture, but because the resin and blocked polyisocyanate are the same as claimed by applicant, these parameters are expected to at least overlap with the values claimed by applicant.

Double Patenting

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 6734260. Although the conflicting claims are not identical, they are not patentably distinct from each other because '260 does not teach Tg or oxygen permeability of the coating, but because the same xylene-formaldehyde-amino-epoxy resins are used as in the instant application, these parameters are expected to at least overlap with the values claimed by applicant.

22. Claims 6-7, 9-10, 13-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being obvious over Nishiguchi et al (6734260).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

'260 teaches a coating composition of a xylene-formaldehyde-amino epoxy resin (180-2500 epoxy equivalents), along with a blocked polyisocyanate (that has been further reacted with a compound such as propylene glycol) (see Abstract, 7:35-63, claim 22).

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'260 does not teach Tg or oxygen permeability of the coating, but because the same xylene-formaldehyde-amino-epoxy resins are used as in the instant application, these parameters are expected to at least overlap with the values claimed by applicant.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

September 22, 2005